

Filed Electronically on:
April 26, 2010
Ser. No. 10/679,749

Remarks

The response is timely because it is filed within the two month period for reopening prosecution after a Board decision raising one or more new grounds of rejection (two are raised here).

35 U.S.C. 112, First Paragraph (Written Description)

Pages 19-22 of the Board decision enter a new ground of rejection of claims 1, 2, and 5-64, based on alleged lack of support in the original specification for the "without data processing" limitations of those claims. The Applicant does not concede this point, but has addressed the new ground of rejection by amending the claims as presented above to remove the "without data processing" limitation. Therefore, this rejection is seen to be overcome. Support for claims 1, 19, and 30 as presently amended is shown below.

35 U.S.C. § 103(a) (Obviousness)

Claims 1,19, and 30 and their dependent claims 5-18, 20-29, and 31-64 are pending in the present application. The proposed rejection from the Board is found in the Board decision Mailed February 26, 2010 ("Board Decision").

The Board decision, p.11, item 46, notes that "Neither Segal nor Joao discloses ... employing a 'service provider' to induce a patient to perform certain actions." Claim 1 requires the service provider to carry out the following elements not shown by the applied prior art:

- "A. inducing said patient to receive said medical record from a covered entity in a first format;
- B. inducing said patient to convert said medical record to a storage format by summarizing, abstracting, retyping, redacting, supplementing, organizing, or selecting the medical record, without the service provider modifying the

Filed Electronically on:
April 26, 2010
Ser. No. 10/679,749

information or its format in the medical record, wherein said storage format is different from said first format....”

The Board decision reasons that the service provider inducing the patient to receive and pass on an unmodified medical record is obvious, but the claims have been changed to require Step B of claim 1 as recited above, or its counterpart in claims 19 and 30. It is not obvious from the cited prior art for a service provider, who is neither the physician providing the original records nor the patient, to induce the patient to obtain his or her original records, induce the patient to modify the original records, receive the modified records, and distribute the modified records to third parties as directed by the patient, without further changes. The Joao and Siegel prior art do not show the patient modifying the records. In both items of prior art, any modifications are made by a service provider or physician. This in effect creates new medical records, which are then covered by HIPAA.

35 U.S.C. § 132 (Amendments Supported)

Claims 1, 19, and 30 of the present application as amended are shown in the left column below. Each amendment finds support as stated in the right column below.

Support for amended claim 1

A method for a service provider to obtain a medical record of a patient from a covered entity in a form allowing said service provider to quickly disclose said medical record to a third party without restriction by the Health Insurance Portability and Accountability Act of 1996, the method comprising the following steps carried out by a service	Claim 1 as submitted on appeal, not rejected re written description.
--	--

Filed Electronically on:
 April 26, 2010
 Ser. No. 10/679,749

provider that is not the patient or a covered entity:	
A. inducing said patient to receive said medical record from a covered entity in a first format;	Claim 1 as submitted on appeal, this portion not rejected re written description, except adding "in a first format." See also Par 0026 of the specification, which states, in relevant part: "The communication interface of the system may be adapted to <u>induce a patient to obtain possession of a medical record in a first format</u> and then convert the medical record to a storage format different from the first format."
B. inducing said patient to convert said medical record to a storage format,	From claim 2, this portion not rejected re written description, see also Par 0026 of the specification, which states, in relevant part: "The communication interface of the system may be adapted to <u>induce a patient to ... convert the medical record to a storage format</u> different from the first format."
by summarizing, abstracting, retyping, redacting, supplementing, organizing, or selecting the medical record,	Par 0016 and 0052 of the specification, which state, in relevant part: [0016] * * * "As another example, the

	<p>patient can provide to the service provider a record that has been <u>summarized, abstracted, retyped, redacted, supplemented,</u> ... or otherwise modified from its original form.</p> <p>[0052] * * * By obtaining the agreement in advance, the patient can search for, obtain, and <u>organize the records</u> thoroughly and accurately, <u>select what information to make available,</u> and/or transmit the information in a suitable format to the service provider <u>so it will be available and arranged in good order</u> in an emergency.</p>
<p>without the service provider modifying the information or its format in the medical record</p>	<p>Par 0020 of the specification, which states, in relevant part:</p> <p>"[0020] The service provider then stores or induces the patient to store the medical record in a memory. <u>The medical record is stored</u> in a form from which it can be reproduced in the storage format as received from the patient. * * * The intention here is to <u>avoid</u> the need for <u>the service provider to modify the information or its format</u></p>

	in a way that could be interpreted as "data processing," as discussed in HIPAA."
wherein said storage format is different from said first format	From claim 2, this portion not rejected re written description. See also Par 0026 of the specification, which states, in relevant part: "The communication interface of the system may be adapted to induce a patient to ... convert the medical record to <u>a storage format different from the first format.</u> "
C. receiving said medical record from said patient in said storage format;	Claim 1, part B, as submitted on appeal, this portion not rejected re written description. See also Par.0025 of the specification, which states in relevant part: "The communication interface can be used for ... <u>acquiring the medical record from the patient in a storage format.</u> "
D. storing said medical record in a memory in a form from which said medical record can be reproduced in said storage format;	Claim 1, part C, as submitted on appeal, this portion not rejected re written description
E. obtaining agreement in advance	Claim 1, part D, as submitted on

Filed Electronically on:
 April 26, 2010
 Ser. No. 10/679,749

with the patient that the service provider shall transmit said medical record to a third party	appeal, this portion not rejected re written description
in the storage format as received from the patient	Par 0038 of the specification, which states, in relevant part: "[A] medical file storage system based on the present invention copies, stores, retrieves, and delivers medical information <u>in the storage format as received from the patient....</u> "
under defined conditions; and	Claim 1, part D, as submitted on appeal, not rejected re written description
F. transmitting said medical record to a third party	Claim 1 as submitted on appeal, not rejected re written description
in the storage format as received from the patient	Par [0038] of the specification, which states, in relevant part: "[A] medical file storage system based on the present invention copies, stores, retrieves, and delivers medical information <u>in the storage format as received from the patient....</u> "
when the defined conditions occur.	Claim 1 as submitted on appeal, not rejected re written description

Support for Claim 19

Filed Electronically on:
 April 26, 2010
 Ser. No. 10/679,749

<p>19. A method to induce conversion of a medical record of a patient from a covered entity to a form allowing quick disclosure of said medical record to a third party without restriction by the Health Insurance Portability and Accountability Act of 1996, the method comprising:</p> <p>A. a service provider that is not the patient or a covered entity, inducing said patient to obtain possession of said medical record from a covered entity;</p> <p>B. said service provider inducing said patient to convert said medical record into a storage format</p>	<p>Claim 19 as submitted on appeal, not rejected re written description.</p>
<p>by summarizing, abstracting, retyping, redacting, supplementing, organizing, or selecting the medical record, without the service provider modifying the information or its format in the medical record, wherein said storage format is different from said first format; and</p>	<p>Par 0016, 0052, and 0020 of the specification, which state, in relevant part:</p> <p>[0016] * * * "As another example, the patient can provide to the service provider a record that has been <u>summarized, abstracted, retyped, redacted, supplemented,</u> ... or otherwise modified from its original form.</p> <p>[0052] * * * By obtaining the</p>

Filed Electronically on:
April 26, 2010
Ser. No. 10/679,749

	<p>agreement in advance, the patient can search for, obtain, and <u>organize the records</u> thoroughly and accurately, <u>select what information to make available</u>, and/or transmit the information in a suitable format to the service provider <u>so it will be available and arranged in good order</u> in an emergency.</p> <p>"[0020] The service provider then stores or induces the patient to store the medical record in a memory. <u>The medical record is stored</u> in a form from which it can be reproduced in the storage format as received from the patient. * * * The intention here is to <u>avoid the need for the service provider to modify the information or its format</u> in a way that could be interpreted as "data processing," as discussed in HIPAA."</p>
C. said service provider inducing said patient to store said medical record in a memory in said storage format.	Claim 19 as submitted on appeal, not rejected re written description.

Support for Claim 30

Filed Electronically on:
 April 26, 2010
 Ser. No. 10/679,749

<p>30. (Currently amended) A medical and personal information system for obtaining and storing a medical record of a patient from a covered entity in a form allowing quick disclosure of said medical record to a third party without restriction by the Health Insurance Portability and Accountability Act of 1996, the system comprising:</p> <p>A. a communication interface provided at least in part by a service provider that is not the patient or a covered entity, said interface being adapted for inducing said patient to obtain possession of said medical record of said patient from a covered entity</p>	<p>Claim 30 as submitted on appeal, not rejected re written description.</p>
<p>and to induce said patient to convert said medical record to a storage format by summarizing, abstracting, retyping, redacting, supplementing, organizing, or selecting the medical record, without the service provider modifying the information or its format in the medical record, wherein said storage format is different from said first format;</p>	<p>Par 0016, 0052, and 0020 of the specification, which state, in relevant part:</p> <p>[0016] * * * "As another example, the patient can provide to the service provider a record that has been <u>summarized, abstracted, retyped, redacted, supplemented</u>, ... or otherwise modified from its original form.</p>

Filed Electronically on:
 April 26, 2010
 Ser. No. 10/679,749

	<p>[0052] * * * By obtaining the agreement in advance, the patient can search for, obtain, and <u>organize the records</u> thoroughly and accurately, <u>select what information to make available</u>, and/or transmit the information in a suitable format to the service provider <u>so it will be available and arranged in good order</u> in an emergency.</p> <p>"[0020] The service provider then stores or induces the patient to store the medical record in a memory. <u>The medical record is stored</u> in a form from which it can be reproduced in the storage format as received from the patient. * * * The intention here is to <u>avoid the need for the service provider to modify the information or its format</u> in a way that could be interpreted as "data processing," as discussed in HIPAA."</p>
<p>and</p> <p>B. a data storage device provided at least in part by a service provider that is not the patient or a covered entity, said storage device comprising a</p>	<p>Claim 30 as submitted on appeal, not rejected re written description.</p>

Filed Electronically on:
April 26, 2010
Ser. No. 10/679,749

memory adapted for storing said medical record in a form from which it can be reproduced in a storage format, wherein said storage device is configured to store said medical record in said storage format.	
--	--

The amendments in this paper are therefore free of new matter.

-- continued next page --

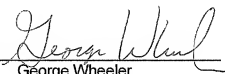
**Filed Electronically on:
April 26, 2010
Ser. No. 10/679,749**

Conclusion

In view of the above remarks, the applicant respectfully requests reconsideration and allowance of all the pending claims (1-2 and 5-64).

The Commissioner is hereby authorized to charge any additional fees, or credit any overpayment, to Deposit Account No. 13-0017.

Respectfully submitted,

By: 
George Wheeler
Reg. No. 28,766
Attorney for Applicant(s)

Dated: April 26, 2010

McAndrews, Held & Malloy, Ltd.
500 West Madison Street
Chicago, IL 60661
Telephone: (312) 775-8000
FAX: (312) 775-8100